

ESTTA Tracking number: **ESTTA769718**

Filing date: **09/09/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|---------------------------------------|---|
| Name | Jaguar Land Rover Limited |
| Granted to Date of previous extension | 09/14/2016 |
| Address | Abbey RoadWhitley Coventry, CV3 4LF UNITED KINGDOM |
| Attorney information | Jennifer K. Ziegler Brooks Kushman PC 1000 Town Center#2200 Southfield, MI 48075 UNITED STATES jziegler@brookskushman.com, mdorosh@brookskushman.com |

Applicant Information

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|------------------------|--|------------------------|------------|
| Application No | 86835257 | Publication date | 05/17/2016 |
| Opposition Filing Date | 09/09/2016 | Opposition Period Ends | 09/14/2016 |
| Applicant | Alvarez, Jonhatan 11657 Killian St el monte, CA 91732 UNITED STATES | | |

Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: t-shirts; dresses; shirts; suits; pants; Shoes; socks


Grounds for Opposition


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|---|------------------------------------|
| Priority and likelihood of confusion | Trademark Act Section 2(d) |
| Dilution by blurring | Trademark Act Sections 2 and 43(c) |
| False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute | Trademark Act Section 2(a) |

Marks Cited by Opposer as Basis for Opposition


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|-----------------------|--------|------------------|------------|
| U.S. Registration No. | 423961 | Application Date | 11/26/1945 |
|-----------------------|--------|------------------|------------|


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|---------------------|--|-----------------------|------|
| Registration Date | 09/17/1946 | Foreign Priority Date | NONE |
| Word Mark | JAGUAR | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 012. First use: First Use: 1935/00/00 First Use In Commerce: 1935/00/00 AUTOMOBILES, [BUSES, MOTOR VANS,] ANDPARTS THEREOF | | |

| | | | |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1562075 | Application Date | 03/06/1989 |
| Registration Date | 10/24/1989 | Foreign Priority Date | NONE |
| Word Mark | JAGUAR | | |
| Design Mark |  | | |
| Description of Mark | THE MARK CONSISTS OF A LEAPING JAGUAR ABOVE THE TERM "JAGUAR". | | |
| Goods/Services | Class 012. First use: First Use: 1983/02/00 First Use In Commerce: 1983/02/00 AUTOMOBILES AND STRUCTURAL PARTS THEREOF | | |


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|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1634877 | Application Date | 01/12/1990 |
| Registration Date | 02/12/1991 | Foreign Priority Date | NONE |
| Word Mark | JAGUAR | | |
| Design Mark |  | | |
| Description of | NONE | | |

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|----------------|--|
| Mark | |
| Goods/Services | Class 025. First use: First Use: 1984/09/00 First Use In Commerce: 1984/09/00 ties, shirts, sweaters, hats and jackets |

| | | | |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 2286996 | Application Date | 08/04/1997 |
| Registration Date | 10/19/1999 | Foreign Priority Date | NONE |
| Word Mark | JAGUAR | | |
| Design Mark |  | | |
| Description of Mark | The mark consists of a leaping jaguar above the term "JAGUAR". | | |
| Goods/Services | Class 025. First use: First Use: 1984/09/00 First Use In Commerce: 1984/09/00 clothing, namely, hats, [scarves, trousers,] gloves [, belts and socks] | | |

| | | | |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 4246042 | Application Date | 05/03/2012 |
| Registration Date | 11/20/2012 | Foreign Priority Date | NONE |
| Word Mark | JAGUAR | | |
| Design Mark |  | | |
| Description of Mark | The mark consists of the word "JAGUAR" with the picture of a Jaguar above leaping to the left. | | |
| Goods/Services | Class 025. First use: First Use: 0 First Use In Commerce: 0 Clothing, namely, t-shirts, fleece pullovers, sweaters, coveralls, sweat-shirts,jackets, polo shirts; headwear, namely,hats, visors and caps; gloves; ties; shoes | | |

| | | | |
|-------------------|---------|------------------|------------|
| U.S. Registration | 4554057 | Application Date | 05/12/2011 |
|-------------------|---------|------------------|------------|

| | | | |
|---------------------|--|-----------------------|------------|
| No. | | | |
| Registration Date | 06/24/2014 | Foreign Priority Date | 05/06/2011 |
| Word Mark | JAGUAR | | |
| Design Mark |  | | |
| Description of Mark | The mark consists of the word "JAGUAR" in a stylized format inside of a hexagon. | | |
| Goods/Services | <p>Class 014. First use: First Use: 0 First Use In Commerce: 0 cuff links, tie pins, tie clips; silverkey fobs in precious metals or coated therewith; key rings of precious metal</p> <p>Class 016. First use: First Use: 0 First Use In Commerce: 0 Printed matter, namely, paper signs, books, manuals, curriculum, newsletters, informational cards and brochures in the field of automobiles and automobile services, stationery, posters, maps, guide books featuring automobiles and automobile services, printed periodicals in the field of automobiles and automobile services, general feature magazines, newspapers and printed publications, namely, catalogues, leaflets, magazines, pamphlets, travel guides, handbooks, journals, in the field of automobiles and automobile services; decorative pencil-top ornaments; office requisites other than furniture, namely, envelope sealing machines, paper embossers, and punches; printed instructional and teaching materials in the field of automobiles and automobile services; writing and drawing instruments and writing tablets; paper; paper drink mats, photographs, calendars, stickers, paper labels, decalcomanias, drawing rulers, postcards, bookmarks, bookends, erasers, paperweights, and book covers; diaries, notebooks, appointment books, address books, combinations of such goods, and covers therefore; desktop holders for business cards, check book covers, and passport covers and holders; folders, holders and covers, all intended for or containing notebooks; notepads, paper; art prints on canvas; pens, pencils, and/or erasers; road and vehicle tax disc holders made of plastic film or sheet materials in the nature of envelopes; paper towels, paper napkins, paper serviettes, paper mats, paper coasters, paper handkerchiefs, paper tissues, paper table cloths, disposable wipes not impregnated with chemicals or compounds, and plastic bags in the shape of tubes for the storage and disposal of waste, including sanitary waste such as diapers and nappies, feminine hygiene products and incontinence products, all made wholly or principally of paper and/or paper derivatives; wrapping and packing materials made wholly or principally of paper with plastics; Paper bags and sacks; Plastic bags for packaging; Merchandise bags; protective covers for sheets or paper and pages of books and the like; disposable paper protectors for carpets and seats; Disposable paper sheets for personal hygienic use in the nature of disposable headrest covers not for medical use; Boxes, cartons, storage containers, and packaging containers made of paper or cardboard; money clips; desk sets comprised of holders for paper and writing instruments, and desktop organizers</p> <p>Class 018. First use: First Use: 0 First Use In Commerce: 0 Articles made of leather or of imitation leather, namely, traveling bags; vanity cases sold empty; attaché cases; document cases; suitcases; pocket wallets;</p> | | |

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| | <p>purses; handbags; parasols; umbrellas; walking sticks; umbrella sticks; wallets; rucksacks; business card cases</p> <p>Class 021. First use: First Use: 0 First Use In Commerce: 0</p> <p>Household utensils, namely, spatulas, rolling pins, turners and containers for household use; drinking steins; mugs; cups; espresso sets comprised of espresso drinking cups and saucers, beverage glassware; thermal insulated containers for beverages; plastic water bottles, sold empty; portable coolers and tankards not of precious metal</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0</p> <p>Clothing, namely, t-shirts, fleece pullovers, sweaters, coveralls, sweat-shirts,jackets, polo shirts, headwear, namely,hats, visors and caps; gloves; ties; shoes</p> <p>Class 028. First use: First Use: 0 First Use In Commerce: 0</p> <p>Toy model vehicles and related accessories sold as units, namely, toy model vehicle kits; battery-powered computer gamewith LCD screen; golf balls and golf bags; stuffed toy animals; playing cards</p> |
|--|--|

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|-------------|--|
| Attachments | <p>73784806#TMSN.png(bytes)</p> <p>74018612#TMSN.png(bytes)</p> <p>75334987#TMSN.png(bytes)</p> <p>85615345#TMSN.png(bytes)</p> <p>85318804#TMSN.png(bytes)</p> <p>Notice of Opposition JAGUAR PRADO CLOTHING CO.pdf(45826 bytes)</p> |
|-------------|--|

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|---------------------|
| Signature | /jennifer ziegler/ |
| Name | Jennifer K. Ziegler |
| Date | 09/09/2016 |

In re Trademark Application

Filed: December 1, 2015

Published in the Official Gazette on May 17, 2016

Atty. Docket No.: JAGW7594OC

Opposer,

V.

Applicant.

Opposition No. _____

VIA ELECTRONIC FILING
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Opposer, Jaguar Land Rover Limited, a United Kingdom private company limited by shares, having a principal place of business at Abbey Road, Whitley, Coventry CV3 4LF, United Kingdom (“Opposer”), believes that it is and will continue to be damaged by registration of the mark JAGUAR PRADO CLOTHING CO. in the name of Jonhatan Alvarez (“Applicant”) shown in U.S. Trademark Application Serial No. 86/835,257, and hereby opposes the same.

A request for an extension of time to oppose was filed on May 25, 2016 and was granted, extending the time to file to September 14, 2016.

As grounds for opposition, Opposer alleges that:

1. Opposer and its predecessors have manufactured and sold vehicles, vehicle parts and accessories, and a wide variety of related automotive and non-automotive goods and services worldwide for over 80 years.

2. Since at least as early as 1935, Opposer has owned and used the trademark JAGUAR in connection with motor vehicles, vehicle parts and accessories, and related automotive and non-automotive goods and services in the United States and throughout the world.

3. In the United States, Opposer is the owner of, among others, the following registrations for JAGUAR covering motor vehicles, vehicle parts and accessories, and related goods in Class 12: U.S. Trademark Registration Nos. 423,961 (registered September 17, 1946); and 1,562,075 (registered October 24, 1989). These registrations are valid and subsisting, uncanceled, and unrevoked, and the 1,562,075 registration is incontestable.

4. In the United States, Opposer is the owner of, among others, the following registrations for JAGUAR covering clothing in Class 25: U.S. Trademark Registration Nos. 1,634,877 (registered February 12, 1991); 2,286,996 (registered October 19, 1999); 4,246,042 (registered November 20, 2012); and 4,554,057 (registered June 24, 2014). These registrations are valid and subsisting, uncanceled, and unrevoked, and the 1,634,877 and 2,286,996 registrations are incontestable.

5. Opposer has expended considerable time, effort, and expense in advertising and promoting the JAGUAR Mark and the goods and services associated with it throughout the United States, with the result that the purchasing public has come to know and recognize goods and services of Opposer by the JAGUAR Mark. Opposer has exceedingly valuable goodwill established in its JAGUAR Mark.

6. Applicant is seeking to register JAGUAR PRADO CLOTHING CO. as a trademark for “t-shirts; dresses; shirts; suits; pants; shoes; socks” in Class 25. This is evidenced by publication of the mark in the *Official Gazette* on May 17, 2016. Applicant filed this intent-to-use application on December 1, 2015.

7. There is no issue as to priority. Opposer used, filed, and registered the JAGUAR Mark in connection with its goods and services long prior to Applicant’s December 1, 2015 filing date.

8. Upon information and belief, Applicant did not use its JAGUAR PRADO CLOTHING CO. mark prior to Opposer’s first use of JAGUAR.

9. The JAGUAR component of Applicant’s JAGUAR PRADO CLOTHING CO. mark is identical to Opposer’s JAGUAR Mark.

10. The JAGUAR component of Applicant’s JAGUAR PRADO CLOTHING CO. mark is the dominant component of Applicant’s mark.

11. Applicant’s JAGUAR PRADO CLOTHING CO. mark is a close approximation of Opposer’s JAGUAR Mark.

12. Applicant’s JAGUAR PRADO CLOTHING CO. mark is confusingly similar to Opposer’s senior JAGUAR Mark.

13. Because the purchasing public has come to recognize and associate the goods of Opposer by the JAGUAR Mark, Applicant’s proposed JAGUAR PRADO CLOTHING CO. mark is likely to be confused with or suggest a connection to Opposer.

14. Opposer is not connected with the goods sold or intended to be sold by Applicant under its JAGUAR PRADO CLOTHING CO. mark.

15. The fame and reputation of Opposer is such that, if Applicant's JAGUAR PRADO CLOTHING CO. mark is used with Applicant's designated goods, a connection with Opposer will be presumed.

16. Through extensive use and promotion of the JAGUAR Mark by Opposer and/or its authorized dealers, Opposer's JAGUAR Mark has become distinctive and famous as defined under Section 43(c)(2) of the Lanham Act, as amended, 15 USC 1125(c)(2), and it was famous prior to the filing date of Applicant's application for the JAGUAR PRADO CLOTHING CO. mark.

17. Applicant's JAGUAR PRADO CLOTHING CO. mark in Application No. 86/835,257 so resembles Opposer's JAGUAR Mark and the goods identified are so closely related to the goods of Opposer as to be likely, when used in connection with Applicant's goods, to cause confusion, or to cause mistake, or to deceive in violation of Section 2(d) of the Lanham Act, 15 USC §1052(d).

18. Applicant's JAGUAR PRADO CLOTHING CO. mark in Application No. 86/835,257 so resembles Opposer's JAGUAR Mark and the goods identified are so closely related to the goods of Opposer as to be likely, when used in connection with Applicant's goods, to falsely suggest a connection with Opposer in violation of Section 2(a) of the Lanham Act, 15 USC §1052(a).

19. Applicant's JAGUAR PRADO CLOTHING CO. mark in Application No. 86/835,257 is likely to cause, and will cause, dilution of the distinctive value of Opposer's JAGUAR Mark in violation of Section 43(c) of the Lanham Act, 15 USC §1125(c).

20. If Applicant were granted the registration herein opposed, it would obtain at least a *prima facie* exclusive right to use of the JAGUAR PRADO CLOTHING CO. mark in

connection with the designated goods. Such registration would be a source of injury and damage to Opposer's prior and established rights in its JAGUAR Mark.

WHEREFORE, Opposer respectfully requests that registration of the JAGUAR PRADO CLOTHING CO. mark, Application Serial No. 86/835,257, be refused and that this opposition be sustained.

The fee required under 37 C.F.R. § 2.6(a)(17) is being paid electronically concurrently with the filing of this Notice of Opposition. If the filing fee is found to be insufficient for any reason, please charge such deficiency to the deposit account.

Respectfully submitted,

By: 
Jennifer K. Ziegler

Attorneys/Agents for Opposer

Date: September 9, 2016

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
Phone: 248-358-4400
Fax: 248-358-3351

CERTIFICATE OF SERVICE

I certify that I served:


NOTICE OF OPPOSITION

On September 9, 2016 by First Class Mail and electronic mail to:

Luke Brean
BreanLaw LLC
P.O. Box 4120 ECM #72065
Portland, OR 97208

Courtesy Copy via electronic mail to tmsupport@breanlaw.com

Attorney/Agent for Applicant

By: 
Jennifer K. Ziegler
Attorneys/Agents for Opposer